II. REMARKS

Upon entry of this Amendment, claims 53 to 69 will be pending. Claims 1 to 34 were previously canceled. Claims 35 to 52 are canceled without prejudice or disclaimer of the underlying subject matter by this Amendment and claims 53 to 69 are new. Support for the new claims may be found in the specification and claims as originally filed. *See, for example*, page 2, Examples 1 and 2, and original claims 1 to 34. No new matter is added by way of this Amendment.

The Applicants request entry of this amendment under 37 C.F.R. § 1.116 in that it places the application and claims in better consideration for allowance or appeal.

1. Claim Rejection under 35 U.S.C. § 112, first paragraph – Written Description:

Claim 50 was rejected under 35 U.S.C. § 112, first paragraph, for allegedly "failing to comply with the written description requirement." Office Action at page 2. This claim is canceled without prejudice or disclaimer of the underlying subject matter rendering the rejection moot. Therefore, the Applicants respectfully request withdrawal of this rejection.

2. Claim Rejections under 35 U.S.C. § 102:

Claims 35 to 37, 41, 42, 45, 46, and 48 to 50 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Fleming *et al.*, *Plant J.* **10(4)**, 745–754, 1996. Office Action at page 8. The Applicants respectfully traverse this rejection.

As an initial matter, claims 35 to 37, 41, 42, 45, 46, and 48 to 50 are canceled without prejudice or disclaimer of the underlying subject matter. With respect to the added claims, Fleming *et al.* do not teach, *inter alia*, a method for detecting expression of a first transgenic

nucleic acid molecule operably linked to a second transgenic nucleic acid molecule, by detecting complementary DNA (to mRNA produced from the second transgenic nucleic acid molecule) by hybridization with at least one oligonucleotide designed to hybridize with the complementary DNA, wherein the hybridization indicates expression of the first transgenic nucleic acid molecule.

Indeed, Fleming *et al.* have no need to determine expression of a first transgenic nucleic acid molecule by hybridization of complementary DNA with at least one oligonucleotide because they detect expression of "a first transgenic nucleic acid molecule" by fluorescence imaging. See Abstract of Fleming *et al.* ("This paper reports on a fluorescent imaging technique for the analysis of GUS reporter gene expression ..."). Because Fleming *et al.* do not teach each and every limitation of the claims, Fleming *et al.* cannot anticipate any of the pending claims, all of which have this limitation. Therefore, the Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b) over Fleming *et al.*

Claims 35, 41, 47, and 49 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Hamilton, *Gene* **200**, 107–116, 1997. Office Action at page 13. The Applicants respectfully traverse this rejection.

Once again, claims 35, 41, 47, and 49 are canceled without prejudice or disclaimer of the underlying subject matter. With respect to the new claims, Hamilton also does not teach, *inter alia*, a method for detecting expression of a first transgenic nucleic acid molecule operably linked to a second transgenic nucleic acid molecule, by detecting the complementary DNA by hybridization with at least one oligonucleotide designed to hybridize with the complementary DNA, wherein the hybridization indicates expression of the first transgenic nucleic acid

molecule. In other words, Hamilton does not teach each and every limitation of the claims and cannot anticipate any of the pending claims, all of which have this limitation. Therefore, the Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b) over Hamilton.

3. Claim Rejections under 35 U.S.C. § 103:

Claims 35 to 52 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hunt, *DNA* **7(5)**, 329–336, 1988 in view of Freeman *et al.*, *BioTechniques* **26(1)**, 112–125, 1999. Office Action at page 16. The Applicants respectfully traverse this rejection.

In the Examiner's reading of Hunt, the pAH10 is the first transgenic nucleic acid while the rbcS region is the second transgenic nucleic acid. *Id.* at page 17. The Examiner goes on to state that Hunt "detects the rbcS by the S1 nuclease assay". *Id.* In other words, the Examiner admits that Hunt detects the second transgenic nucleic acid.

By contrast, the pending claims are directed to the detection of the first transgenic nucleic acid. The Examiner also admits that all Freeman *et al.* add to Hunt is that "Freeman teaches the benefits of PCR, specifically utilizing quantitative RT-PCR, both competitive and non-competitive (pp. 116-117) to quantify mRNA (claims 36, 41, 42)." *Id.* In other words, Freeman *et al.* do not overcome the deficiencies of Hunt in that Freeman *et al.* do not teach detection of the first transgenic nucleic acid. Therefore, the combination of Hunt and Freeman *et al.* does not teach or fairly suggest all the claim limitations.

In conclusion, the Applicants respectfully submit that the pending claims are not unpatentable over Hunt in view of Freeman *et al.*, and respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

III. CONCLUSION

In view of the foregoing amendments and remarks, the Applicants respectfully submit that the present application is now in condition for allowance, and respectfully request notice of such. The Examiner is encouraged to contact the undersigned at 202-942-5746 if any additional information is necessary for allowance.

Respectfully submitted,

Date: November 6, 2006

Gautam Prakash, Ph.D. (Reg. Agent No. 53,481)
Thomas E. Holsten (Reg. Atty. No. 46,098)
David R. Marsh (Reg. Atty. No. 41,408)

Arnold & Porter LLP
555 Twelfth Street, N.W.
Attn: IP Docketing
Washington, DC 20004

Tel: 202-942-5000
Fax: 202-942-5999

Of Counsel:

Lawrence M. Lavin, Jr. (Reg. No. 30,768)
Thomas E. Kelley (Reg. No. 29,938)
Monsanto Company